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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,609	03/09/2004	Eiji Kato	FY.51042US1A	1785
20995 7590 10/08/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER ILAN, RUTH				
ART UNIT 3616		PAPER NUMBER		
NOTIFICATION DATE 10/08/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/796,609

Applicant(s)

KATO ET AL.

Examiner

Ruth Ilan

Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 5-19 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 20 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As seen in the Figures of the instant Application, the frame clearly supports a load container (see Figure 1, element 92 is a load container.)

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-19 and 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Seto (US 6,250,415.) Please see Figure 1 and 2. Seto teaches an off-road vehicle including a plurality of wheel and a prime movers. The frame comprises a

plurality of frame members and the frame members are in first and second groups; 28 and 30 are in the first group and 34 and 46 are the second group and as seen in Figure 2 at least a portion of the exhaust system is between the frame members of the second group. They overlap as claimed, in a rear section of the first group and a front of the second group, and the rear section of the first group defines a first portion coupled with the second group, and vice-versa (see Figure 1 front of 34 connects to rear section of 28 and front of 46 connects at rear section of 30.) Regarding claim 10, the rear section of the first group is wider than the front section of the second group (because 28 angles outward see Figure 2.) Regarding claims 11 and 16, the front section of 30 is interposed between the front wheels, and the front wheels are coupled with the front section. Regarding claim 12 and 18, the front section of the first group is narrower than the rest of the frame and so meets this limitation (see Figure 2, 28 bends in towards 44.) . Regarding claims 13 and 17, the rear section (46, 34 is interposed between the rear wheels and the rear wheels are coupled (via arm 66) to 46, see Figure 1.) Regarding claim 14, the back end of 34 is narrower, as claimed (see Figure 2.) Regarding claim 15, as seen in Figure 2, the frame is symmetrical. Regarding claim 19, the back end of 28 can fairly be termed part of the rear section that includes a front member and the coupling is as claimed, with the front portion of 34. Regarding claim 21, the frame members are tubular. . Regarding claim 24, 28 supports the front, and 46, supports the rear of the prime mover.

3. Claims 9- 19 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosuge (US 4,798,400.) Please see Figure 2 and 3. Kosuge teaches an off-road

vehicle including a plurality of wheel and a prime mover. The frame comprises a plurality of frame members and the frame members are in first and second groups; 1 and 2 are in the first group and 6 and 7 are in the second. They overlap as claimed, in a rear section of the first group and a front of the second group, and the rear section of the first group defines a first portion coupled with the second group, and vice-versa (see Figure 3.) Regarding claim 10, as best understood, the rear section of the first group is wider than the front section of the first group (because 1 angles outward.) Regarding claims 11 and 16, the front section of 1 is interposed between the front wheels, and the front wheels are coupled with the front section (see col. 3, liens 40-45.) Regarding claim 12 and 18, the front section of the first group (of frames 1) is narrower than the rest of the frame and so meets this limitation. Regarding claims 13 and 17, the rear section (of 7) is interposed between the rear wheels and the rear wheels are coupled (via 23) to 7. Regarding claim 14, 7C is narrower, as claimed (see Figure 2.) Regarding claim 15, as seen in Figure 2, the frame is symmetrical. Regarding claim 19, the back end of 1 can fairly be termed part of the rear section that includes a front member. and the coupling is as claimed. Regarding claim 21, the frame members are tubular. Regarding claim 22 and 23, frame member 1 is rectangular and dimensioned as claimed. Regarding claim 24, 1 supports the front, and 7, via 23, supports the rear of the prime mover.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5-8, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosuge (US 4,798,400.) Kosuge teaches an off-road vehicle having a frame (see Figure 3) a plurality of wheels having at least one front wheel (10) and a prime mover (18) powering at least one of the wheels, the prime mover being mounted on the frame (see Figure 3) and the frame having a plurality of frame portions including at least first, second and third frame portions that extend adjacent to the primer mover, the first and second frame (7, 7a, and 2) being disposed generally to the lateral sides of the prime mover with the third frame portion (7b) extending generally between the first and second frame portions. Regarding the detachably affixed frame portion extending adjacent to an upper portion of the prime mover, it is the Examiner's position that the member 17 can, broadly and reasonably be considered a frame portion, and it extends in the claimed location. Figure 3 shows that this frame portion is connected to 7 by three attachments, which schematically appear to be screw or rivet connections, but does not specifically disclose that they are detachable. Detachable connections, such as bolts, screws, rivets are well known in the attachment art. Thus it would have been obvious to a person of ordinary skill in the art to select from amongst any of the well known attachment types, as person of ordinary skill has good reasons to pursue the known options within his or her technical grasp.

6. Claims 9- 19 and 21-24 are rejected under 35 U.S.C. 103(a) as being obvious over Kosuge (US 4,798,400) in view of Sato (US 6,250,415.) Please see Figure 2 and 3. Kosuge teaches an off-road vehicle including a plurality of wheel and a prime mover. The frame comprises a plurality of frame members and the frame members are in first and second groups; 1 and 2 are in the first group and 6 and 7 are in the second. They overlap as claimed, in a rear section of the first group and a front of the second group, and the rear section of the first group defines a first portion coupled with the second group, and vice-versa (see Figure 3.) Regarding claim 10, the rear section of the first group also includes 5 and is wider than the front section of the rear group. Regarding claims 11 and 16, the front section of 1 is interposed between the front wheels, and the front wheels are coupled with the front section (see col. 3, lines 40-45.) Regarding claim 12 and 18, the front section of the first group (of frames 1) is narrower than the rest of the frame and so meets this limitation. Regarding claims 13 and 17, the rear section (of 7) is interposed between the rear wheels and the rear wheels are coupled (via 23) to 7. Regarding claim 14, 7C is narrower, as claimed (see Figure 2.) Regarding claim 15, as seen in Figure 2, the frame is symmetrical. Regarding claim 19, the back end of 1 can fairly be termed part of the rear section that includes a front member. and the coupling is as claimed. Regarding claim 21, the frame members are tubular. Regarding claim 22 and 23, frame member 1 is rectangular and dimensioned as claimed. Regarding claim 24, 1 supports the front, and 7, via 23, supports the rear of the prime mover. Kosuge is silent as to the placement of an exhaust system. It is well understood in the vehicle art that internal combustion vehicles include exhaust systems

that are used to exhaust combustion gases away from the occupants of the vehicle. Sato teaches one such exhaust system, as claimed which is located protectively under and between the rear rails of the frame (see Sato col. 6, lines 30-37.) Based on the teaching of Sato, it would have been obvious to one having ordinary skill in the art at the time of the invention to include an exhaust system as claimed on the vehicle of Kosuge, in order to provide a protected way to direct combustion products away from the vehicle.

Allowable Subject Matter

7. Claim 20 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 5/27/2008 have been fully considered but they are not persuasive. Regarding the issue of rejection of previously allowed claims: The Examiner respectfully submits that she did not "make a new search in the mere hope of finding something". She rejected claims that were previously indicated as allowable, under 102(b) using art of record in the case. As such there was clearly a clear error in the previous prosecution of the case. The rejection was not arbitrary, the Office Action clearly mapped out and explained the way in which the prior art anticipated the claim language. It is noted with some interest that the Applicant has not argued the validity of the 102(b) rejection of these claims (using Kosuge and Izumi) but has subsequently amended these claims. Regarding the issue that the amendments were "believed to be allowable", the interview summary clearly states that amendment would "possibly

overcome the prior art cited, pending further search and consideration". Upon further consideration, this Examiner did not find these claims allowable.

9. As to the prior art rejections: The arguments with respect to the anticipation rejections with respect to Kosuge and Izumi are moot in view of the new grounds of rejection. Regarding the arguments with respect to claims 1, 5-8, 25 and 26 as not being obvious over Kosuge, the Examiner respectfully disagrees. Element 17 is very reasonably considered a frame, even if the Applicant and Kosuge term it something differently in the specification. The discussion with respect to what the Applicant fairly considers a frame is useful, but it is irrelevant because none of these limitations are found in the claims., It is noted that the features upon which applicant relies (i.e., a reinforcement member 300 preferably extends between the seat pedestal members, etc see page 13 of Applicant's remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also From MPEP 2111: During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite

different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth Ilan whose telephone number is 571-272-6673. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Nguyen can be reached on 571-272-6952. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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